

RESPONSE

Remarks

Claims 1-11, 13-16, 22-32, 34-46, 48-59, 61-71, 78-88 and 93-100 are pending in the Application. Claims 1, 26, 41, 57, 78 and 79 are in independent format. Applicant now responds to the Examiner's assertions.

Telephone Interviews

The Applicant sincerely thanks Examiner Deane for his courtesy and insight and also thanks Examiner Deane's Supervisor for his courtesy and insight during the telephone interviews. The content of this amendment and response is based on the discussion during the telephone interviews with Examiner Deane and his Supervisor and includes the Applicant's understanding of amendments to the claims that would overcome both the pending §102 and §103 rejections based on the telephone interview discussions.

The Applicant asks the Examiner carefully consider the comments below. If the Examiner carefully and realistically considers the comments below he will see his rejections cannot be maintained.

Section 102 Rejection

Claims 1-11, 13-14, 16, 22-32, 34-35, 37-46, 48-59, 61-62, 64-71, 78-88, 93-100 are rejected under 35 U.S.C. 102(e) as being un-patentable by U.S. Patent Application No. 2003/023,754 to Stein et al (Stein).

Section 102 Response

The Applicant traverses all of the Examiner's assertions, accepts all of the Examiner's admissions and responds as follows. The Applicant may comment on only selected specific comments by the Examiner, but the Applicant still intends to traverse all of the Examiner's assertions.

The Examiner asserts that with respect to Claims 1-11, 13-14, 16, 22-32, 34-35, 37-46, 48-59, 61-62, 64-71, 78-88, 93-100, "Stein teaches such limitations as can be seen from Paragraph 0005, Paragraphs 0006-0010, Paragraphs 0019, 0021-0027, 0030, 0032-0034."

First, the Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Second, the Examiner is reminded that to maintain a *prima case* of anticipation, the identical invention must shown in as complete detail in a single prior art reference as is contained in the anticipated claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Claim 1:

Claim 1 as amended recites A method to provide directory assistance to a caller attempting to place a telephone call to an unavailable telephone number, the method comprising the steps of: detecting a caller's telephone call to an unavailable number on a telephony network; intercepting the telephone call on the telephony network to the unavailable number before initiating any action by the telephony network

back to the caller, wherein the unavailable number includes non-existent numbers or numbers not implemented on the telephony network; automatically routing the detected and intercepted telephone call to an automatic intercept system associated with a directory assistance service; automatically routing the detected and intercepted telephone call from the automatic intercept system to the directory assistance service; and providing at least one advertisement to the caller from the directory assistance service.

As discussed with the Examiner, the Applicant defines the term unavailable, for example in Paragraph [0023] "Reasons for an unavailable telephone number can include, but are not limited to: a disconnected subscriber; the telephone number is out of order; the phone number is reserved for future use; the telephone number is unavailable from the caller's area code; the caller failed to enter a 1, 0, and/or area code before the number; the caller entered a 1, 0, or area code before the number when unnecessary; the line is busy; the area code is incorrect or unavailable, and the like. The attempted telephone call can include, but is not limited to, a local telephone call, a toll call (e.g., 900-XXX-XXXX), a toll-free call (i.e., 800-XXX-XXX, 888-XXX-XXXX, etc.), a long distance call, an international call, and the like. An unavailable telephone number includes numbers implemented by the telephone network but, for whatever reason, are unavailable. Additionally, an unavailable telephone number can include numbers that are not implemented by the telephone network (herein non-existent telephone numbers), such as: certain sequences of telephone digits (e.g., 800-1XX-XXXX and 800-XXX-0XXX); numbers that do not exist (065-558-9594); telephone

numbers having area codes that are not implemented (e.g., 999-XXX-XXXX); and the like.”

In direct contrast, Stein teaches in paragraphs [0021] and [0023] a “misdialed number” as numbers, which are similar in their alphanumeric characteristics to commonly used or famous toll-free vanity numbers subscribed to by the Stein system and data structures on the Stein system include all the misdialed numbers subscribed to.

Thus, the Applicant’s unavailable number is not the same as a misdialed number as taught by Stein.

As discussed with the Examiner, in direct contrast Stein teaches a system that re-directs a misdialed number that requires a set of numbers that the system must subscribe to be redirected. The Applicant’s invention has no such requirement. The Applicant’s invention does not require any subscription to any telephone number.

Stein further teaches in the Abstract that “A telephone call redirection system for misdialed telephone numbers is provided. When a caller physically and unintentionally dials one of a set of first numbers subscribed to by the system, the system recognizes the number intended by the caller, and provides the caller with the option of being redirected. If interested, the caller dials another number offered by the system to hear of the desired, intended number.”

Stein further teaches at paragraph [0021] “Using the aforementioned structure, the telephone call redirection system 20 is able to receive a large volume of telephone calls directed to incorrect numbers, identify the correct numbers, communicate

advertisements to the originator of the call, and redirect the call to the correct number.

Such a system is particularly suited for use with toll-free numbers, such as "1-800" numbers wherein an operator of the telephone call redirection system 20 may have subscription rights to a large number of toll-free numbers which are similar in their alphanumeric characteristics to commonly used or famous toll-free vanity numbers.

Using a fictitious number as an example, if the particular well-known number is "1-800-4A-HOTEL" which numerically equates to 1-800-424-6835, the operator of the telephone call redirection system 20 may have subscription rights to such numbers as 1-800-424-6834 and 1-800-424-6836. Therefore, if an originator of a call trying to reach 1-800-4A-HOTEL were to slightly misdial the last digit, the call would be received by the telephone caller redirection system 20, or more specifically, the telephone network interface 22."

Stein further teaches at paragraph [0023] "The telephone call redirection system 20 will be more clearly understood in reference to a typical sequence of steps performed by the telephone call redirection system 20 as indicated in FIG. 2. As shown therein, the system 20 is initiated when a call directed to a first number is received by the telephone network interface 22. This step is indicated by reference numeral 42. The first telephone number is stored in the first data structure 30, which contains all of the misdialed numbers subscribed to by the operator of the system 20. The processor 24 identifies the second number directly linked to the first number, with the second numbers being stored in the second data structure 32. This step is indicated by reference numeral 44 in FIG. 2.

Stein further teaches in paragraph [0032] "The flow chart 300 begins at step 310, wherein the processor 24 receives a call directed to a first telephone number from a caller via the telephone network interface 22. Similar to the example described above, the first telephone number is stored in the first data structure 30, which contains all of the misdialed numbers subscribed to by the operator of the system 20.

Thus misdialed numbers in the Stein application are not redirected to the Stein system unless the misdialed number is subscribed to by the Stein system. If a misdialed number is not subscribed to by the Stein system, it would not be re-directed by the Stein system. Instead the telephony network and not the Stein system would then initiate an immediate action (e.g., playing a message such as "We Sorry.." message directly back to the caller.)

In direct contrast, the Applicant's invention does not require a system that subscribe to any numbers at all. Instead the Applicant's system will re-direct, any unavailable disconnected, out-of-service, not implemented, non-existent and other types of unavailable numbers to the directory assistance service without any action to the caller by the telephony network.

Since Stein does not teach every element as set forth in Claim 1, either expressly or inherently described in a single prior art reference, so Stein cannot anticipate the Applicant's invention under the holding of *Verdegall Bros.* In addition, since Stein does not teach an invention identical to the Applicant's, the Examiner cannot maintain a prima facie case of anticipation under the holding of *Richardson*. Therefore, the Applicant requests the Examiner immediately withdraw the rejections of Claim 1.

Claims 2-11, 13-14, 16, 22-32, 34-35, 37-46, 48-59, 61-62, 64-71, 78-88, 93-100:

The arguments for Claim 1 above are incorporated by reference for all independent claims 26, 41, 57, 78 and 78. The Examiner is reminded that if an independent claim is not anticipated then any claim depending therefrom is not anticipated. Therefore, the Applicant requests the Examiner immediately withdraw the rejections of the dependent claims as well.

Section 103 Rejection

Claims 15, 36, 50 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein in view of U.S. Patent No. 4,850,007 to Marino et al. (Marino).

First Section 103 Response

The Applicant traverses all of the Examiner's assertions, accepts all of the Examiner's admissions and responds as follows. The Applicant may comment on only selected specific comments by the Examiner, but the Applicant still intends to traverse all of the Examiner's assertions. The Section 102 response arguments discussed above are incorporated by reference. The Applicant has explained in detail why independent Claim 1 was not anticipated.

The Examiner is reminded that to establish a case of *prima facie* obviousness of a claimed invention in the first place, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). Stein does not teach or suggest all of the claim limitations taught by Claim 1, including but not limited to a least, intercepting any unavailable number, instead of intercepting only misdialed

numbers that were subscribed to as is taught be Stein.

Claims 15, 36, 50 and 63 are dependent claims adding additional features to the invention. The Examiner is also reminded that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is not obvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Thus, Claims 15, 36, 50 and 63 are not obvious under the holding of *In Re Fine*. Therefore, the Applicant requests the Examiner immediately withdraw the rejections of Claims 15, 36, 50 and 63.

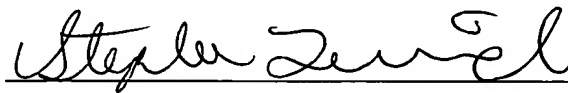
CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §102 and §103 rejections of all the claims and pass all of the pending Claims 1-11, 13-16, 22-32, 34-46, 48-59, 61-71, 78-88 and 93-100 immediately to allowance.

Respectfully submitted.

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